

**CUSTOMER NO.: 24498**  
**Serial No. 09/994,410**  
**Reply to Office Action dated: 07/15/05**  
**Response dated: 09/30/05**

**PATENT**  
**PU010272**

### REMARKS/ARGUMENTS

In the Office Action, the Examiner noted that claims 23-39 are pending in the application and that claims 23-39 stand rejected. All claims are unamended by this response.

In view of the following discussion, the Applicant respectfully submits that none of the claims now presently in the application are anticipated under the provisions of 35 U.S.C. § 102 or obvious under the provisions of 35 U.S.C. § 103. Thus the Applicant believes that all of these claims are now in allowable form.

### Rejections

#### **A. 35 U.S.C. § 102**

The Examiner rejected claim 23-26, 28-33 and 35-39 under 35 U.S.C. § 102(e) as being anticipated by Ellis et al. ((U.S. Patent App. Publication 2002/0174430, hereinafter "Ellis"). The rejection is respectfully traversed.

The Examiner alleges that regarding claims 23 and 31, Ellis discloses a method and system for creating a video program list including all of the limitation of the Applicant's invention. The Applicant respectfully disagrees.

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim" (Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1983)) (emphasis added).

The Applicant submits that the Ellis reference fails to teach, suggest or disclose each and every element of at least the invention as recited in the Applicant's independent claim 23, which specifically recites:

"A method of creating a video program list comprising the steps of:  
 presenting a menu including a first program list of recorded programs;  
 identifying each of said recorded programs in said menu using a title that refers to at least one of a subject matter and an artistic content of said recorded programs;  
 prompting a user to identify at least one recorded program from said first program list to be included in a second program list;  
 creating said second program list, including the at least one identified program;

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**creating an identifier corresponding to said second program list;**  
**including said identifier as a selectable item of said menu."**  
 (emphasis added).

More specifically, the Applicant's invention is directed at least in part to a method of creating a video program list in which a user is prompted to identify at least one recorded program from a first program list to be Included in a second program list, creating the second program list including the identified recorded programs, creating an identifier for the second program list, and including the identifier of the second program list as a selectable item of a menu including at least the first list. In support of at least claim 23, the Applicant in the Specification specifically recites:

"Once he or she has selected the desired video segments, the user can choose the order compilation option, and the user can be prompted to place the video segments (if more than one video segment is selected from the menu) in a desired viewing order. The video segments can then be placed in this order to reflect a customized viewing sequence. An example of this step is shown at FIG. 5. If the user does not select a particular viewing order, then the viewing segments can be placed in a random or default viewing sequence that could be based on any number of schemes including the chronological recording dates of each video segment selected, for example.

In another arrangement, the user can choose the name compilation option and can create an identifier for the compilation. Once the identifier has been created, the compilation can be designated with the identifier. An example of this identification process is shown at FIG. 6." (See Specification, page 6, lines 9-21).

And

"Referring once again to the flowchart 200, at decision block 216, if all the selections are complete, each video segment selected by the user can be compiled to create at least one compilation, as shown at step 218. At step 220, the compilation can be inserted in the menu as a new item. FIG. 7 shows an example of a menu in which the newly generated compilation has been inserted in the menu. Thus, the user can now access the newly generated customized video recording compilation for purposes of viewing a specific set of video segments." (See Specification, page 6, line 28 through page 7, line 2).

As evident from at least the portions of the Applicant's disclosure presented above, in the invention of the Applicant, once a user has selected the desired

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video segments, the user can place the video segments in a desired viewing order in a second program list as evidenced by FIG. 5 of the Applicant's application. That is, the Applicant's FIG. 5 specifically depicts a second program list of video segments identified by a user to be included in a video compilation in accordance with the Applicant's invention. As further evidenced by at least the portions of the Applicant's disclosure presented above, in the invention of the Applicant, a user can create an identifier for the compilation in the second program list. Once the identifier has been created, the compilation can be designated with the identifier. The video segments selected by the user compiled to create at least one compilation, which is identified by the identifier, are inserted as a new item in a menu containing a first program list.

The Applicant respectfully submits that Ellis fails to teach, suggest or anticipate at least a method of creating a video program list including "creating said second program list, including the at least one identified program", "creating an identifier corresponding to said second program list" and "including said identifier as a selectable item of said menu" as taught in the Applicant's Specification and claimed by at least the Applicant's claim 23. More specifically, in contrast to the invention of the Applicant, Ellis teaches methods and systems that provide enhanced personal video recorder ("PVR") and interactive television program guide ("IPG") functionality. In Ellis the application may be used to display a list of PVR recordings, to schedule recordings to a PVR, to configure recordings, to view a list of scheduled recordings, to configure recording settings, or to select delete priority settings for recordings. However, there is absolutely no teaching, suggestion or disclosure in Ellis for at least a method of creating a video program list including "creating said second program list, including the at least one identified program", "creating an identifier corresponding to said second program list" and "including said identifier as a selectable item of said menu" as taught in the Applicant's Specification and claimed by at least the Applicant's claim 23.

More specifically, the Examiner cites paragraph 0378 of Ellis for teaching each and every element of the Applicant's claimed invention. The Applicant respectfully disagrees. In paragraph 0378, Ellis specifically recites:

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"Display screen 9616 may include recording listings 9618 which may contain a list of PVR recordings. Display screen 9616 may include combine after option 9620 and combine before option 9622. Display screen 9616 may provide the user with the ability to move highlight window 9632 over a listing bar in recording listings 9618 and to select combine after option 9620 or combine before option 9622 for the recording identified in that listing bar. A user may be permitted to move a highlight window between listings 9618 and options 9620 and 9622 using right and left remote control navigation keys. A user may be permitted to move highlight window 9632 over a particular listing (e.g., Sports Center) and to combine a recording of that particular listing with a currently selected recording by adding the recording of that particular listing before or after the currently selected recording. By using remote control right and left navigation keys, a user may access combine after option 9620 or combine before option 9622 for that particular listing. Pressing a remote control "OK" key will then cause the recording for that particular listing to be combined with currently selected recording. Display screen 9616 may also include the title, length, and other information related to the currently selected recording. The combined recording may have the name of the originally selected program, the name of the program selected to be combined with it, the user may be able to choose which name to use, or the user may be allowed to enter a new name for the combination. If desired, neither, either or both of the original recordings may be deleted when the combination is created." (See Ellis, paragraph 0378).

In contrast to the invention of the Applicant, in Ellis there is absolutely no teaching, suggestion or disclosure of "creating said second program list, including the at least one identified program", "creating an identifier corresponding to said second program list" and "including said identifier as a selectable item of said menu" as taught in the Applicant's Specification and claimed by at least the Applicant's claim 23. Instead of creating a second program list as taught and claimed in the Applicant's invention, in Ellis a Display screen 9616 provides a user with the ability to move a highlight window 9632 over a listing bar in recording listings 9618 and to select combine after option 9620 or combine before option 9622 for the recording identified in that listing bar. As such in Ellis, a user is permitted to move a highlight window 9632 over a particular listing (e.g., Sports Center) and to combine a recording of that particular listing with a currently selected recording by adding the recording of that particular listing before or after the currently selected recording. Again, this is accomplished in Ellis by moving a window over a particular listing and not by creating a second program listing displaying video segments a user

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wishes to include in a compilation as taught and claimed by at least the Applicant's claim 23.

In addition, there is absolutely no teaching, suggestion or disclosure in Ellis for "creating an identifier corresponding to said second program list" as taught in the Applicant's Specification and claimed by at least the Applicant's claim 23. Instead of creating an identifier corresponding to the second program list as taught and claimed in the Applicant's invention, in Ellis a combined recording may have the name of the originally selected program, the name of the program selected to be combined with it, or the user may be allowed to enter a new name for the combination. That is, in Ellis, a name is chosen for the combination and not for a second program list as taught and claimed by at least the Applicant's claim 23.

Even further, there is absolutely no teaching, suggestion or disclosure in Ellis for "including said identifier as a selectable item of said menu" as taught in the Applicant's Specification and claimed by at least the Applicant's claim 23. Instead of including the created identifier as a selectable item of the original menu as taught and claimed in the Applicant's invention, in Ellis neither, either or both of the original recordings may be deleted when the combination is created. That is, in Ellis, a name chosen for the combination is added to the menu and not an identifier for a second program list as taught and claimed by at least the Applicant's claim 23.

More specifically, the invention of Ellis is unable to perform the taught and claimed functionality of the Applicant's invention. More specifically, in the invention of the Applicant at least with respect to claim 23, a second program list is created from recorded programs identified by a user to be included in the second program list. In this second program list a user is able to place the identified recorded programs in any order for combination and display. In contrast, in the invention of Ellis, a highlight window is moved over an existing bar to combine the highlight window either before or after the existing bar. Subsequently, if a second highlight window is chose for combination with the combination of the first highlight window and the existing bar, the only option is to combine the second highlight window before or after the existing combination. In contrast, in the invention of the Applicant, at least because of the taught and claimed second program list, a user



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is able to arrange any number of identified recorded programs in any order in the second program list for compilation and subsequent viewing in the arranged order. The Applicant respectfully submits that Ellis falls far short of the Applicant's invention as taught and claimed at least with respect to independent claim 23 and that the invention of Ellis is unable to perform at least the above described functionality of the Applicant's invention.

Since Ellis fails to disclose or suggest all of the elements of the Applicant's claim 23, the Applicant respectfully submits that claim 23 is in condition for allowance for at least the reasons stated. That is, the Applicant submits that for at least the reasons recited above independent claim 23 is not anticipated by the teachings of Ellis and, as such, fully satisfies the requirements of 35 U.S.C. § 102 and is patentable thereunder.

Likewise, independent claims 30 and 31 recite similar relevant features as recited in the Applicant's independent claim 23. More specifically, claim 30 recites "creating a list comprising user identified ones of said plurality of recorded programs" and "modifying said menu to include said list as a selectable item on said menu ". Claim 31 recites "said device including a processor programmed to create a list comprising the indicated programs, and to provide an identifier corresponding to said list" and "said processor programmed to modify said menu to include said identifier as a user selectable item of said menu". As described above, there is absolutely no teaching, suggestion or disclosure in Ellis for a method or system for generating a video recording and playback list including a list including user identified ones of recorded programs as claimed by the Applicant's claims 30 and 31. As such, the Applicant submits that for at least the reasons recited above independent claims 30 and 31 are also not anticipated by the teachings of Ellis and also fully satisfy the requirements of 35 U.S.C. § 102 and are patentable thereunder.

Furthermore, dependent claims 24-29 and 32-39, depend either directly or indirectly from independent claims 23, 30 and 31 and recite additional features therefor. As such and for at least the reasons set forth herein, the Applicant submits that dependent claims 24-29 and 32-39 are also not anticipated by the teachings of Ellis. Therefore the Applicant submits that dependent claims 24-29

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and 32-39 also fully satisfy the requirements of 35 U.S.C. § 102 and are patentable thereunder.

The Applicant reserves the right to establish the patentability of each of the claims individually in subsequent prosecution.

**B. 35 U.S.C. § 103**

The Examiner rejected claims 27 and 34 under 35 U.S.C. § 103(a) as being unpatentable over Ellis in view of Okada (U.S. Patent 6,181,870). The rejection is respectfully traversed.

Claims 27 and 34 are dependent claims which depend directly from the Applicant's independent claims 23 and 31, respectively. The Examiner applied Ellis to claims 27 and 34 as applied to reject the Applicant's claims 23 and 31. As recited above and for at least the reasons recited above, the Applicant respectfully submits that Ellis fails to teach, suggest or anticipate at least the Applicant's claims 23 and 31. More specifically, Ellis absolutely fails to teach, suggest or disclose at least "creating said second program list, including the at least one identified program", "creating an identifier corresponding to said second program list" and "including said identifier as a selectable item of said menu" as taught in the Applicant's Specification and claimed by at least the Applicant's claim 23 and as similarly claimed by the Applicant's claim 31. As such, the Applicant respectfully submits that at least because Ellis fails to teach, suggest or anticipate the Applicant's claims 23 and 31, the teachings of Ellis also fail to teach, suggest or anticipate the Applicant's claims 27 and 34 which depend directly from the Applicant's claims 23 and 31, respectively, and recite further limitation thereof.

In addition, the Applicant further submits that Okada absolutely fails to teach, suggest or anticipate at least "creating said second program list, including the at least one identified program", "creating an identifier corresponding to said second program list" and "including said identifier as a selectable item of said menu" as taught in the Applicant's Specification and claimed by at least the Applicant's claim 23 and as similarly claimed by the Applicant's claim 31. As such, the Applicant submits that Okada also fails to teach, suggest or anticipate the

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Applicant's claims 23 and 31 and 27 and 34, and 34 which depend directly from the Applicant's claims 23 and 31, respectively, and recite further limitation thereof.

Lastly, the Applicant submits that the teachings of Okada fail to bridge the substantial gap between the teachings of Ellis and the invention of the Applicant. That is, Ellis and Okada, in any allowable combination, fail to teach, suggest or anticipate at least a method and system for creating a program list including "creating said second program list, including the at least one identified program", "creating an identifier corresponding to said second program list" and "including said identifier as a selectable item of said menu" as taught in the Applicant's Specification and claimed by at least the Applicant's claim 23 and as similarly claimed by the Applicant's claim 31. As such, the Applicant respectfully submits that at least because Ellis fails to teach, suggest or anticipate the Applicant's claims 23 and 31, the teachings of Ellis also fail to teach, suggest or anticipate the Applicant's claims 27 and 34 which depend directly from the Applicant's claims 23 and 31, respectively, and recite further limitation thereof.

Therefore, the Applicant submits that for at least the reasons recited above dependent claims 27 and 34 are not rendered obvious by the teachings of Ellis and Okada, alone or in any allowable combination and, as such, fully satisfy the requirements of 35 U.S.C. § 103 and are patentable thereunder.

The Applicant reserves the right to establish the patentability of each of the claims individually in subsequent prosecution.

#### Conclusion

Thus the Applicant submits that none of the claims, presently in the application, are anticipated under the provisions of 35 U.S.C. § 102 or obvious under the provisions of 35 U.S.C. § 103. Consequently, the Applicant believes that all these claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, or if the Examiner believes a telephone interview would expedite the prosecution of



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the subject application to completion, it is respectfully requested that the Examiner telephone the undersigned.

No fee is believed due. However, if a fee is due, please charge the additional fee to Deposit Account No. 07-0832.

Respectfully submitted,  
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